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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,896	10/06/2000	Ernst August Hahne	320.38785X00	7732

7590 10/11/2002

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EXAMINER

KOCH, GEORGE R

ART UNIT	PAPER NUMBER
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1734

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DATE MAILED: 10/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/647,896

Applicant(s)

HAHNE ET AL.

Examiner

George R. Koch III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☒ Claim(s) 5-9 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

Claim Objections

1. Claims 5-9 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiply dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.
2. Claim 1 objected to because of the following informalities: in line 1, a passage cites "a material web (4) moved in transport direction (v)". Appropriate correction is required. It is suggested that for grammatical correctness that applicant revise the passage to read -- a material web (4) moved in a transport direction (v)--.

Specification

3. The abstract of the disclosure is objected to because it is not one paragraph. Correction is required. See MPEP § 608.01(b).
4. The disclosure is objected to because of the following informalities: There is no brief description of the drawings.

Appropriate correction is required.

Drawings

5. New corrected drawings are required in this application because the application does not have the drawings on a separate sheet of paper (i.e., the single drawing is only present in the application on the front page of the priority application). It is also suggest that applicant add a legend such as "Figure" or "Figure 1". Applicant is advised to

employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 1 recites the limitation "a material web (4) moved in transport direction (v)" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is suggested that applicant amend the passage to read --a material web (4) moved in a transport direction (v)--.

9. Claim 1 recites the limitation "the influence of an electrostatic field" in line 4. There is insufficient antecedent basis for this limitation in the claim. It is suggested that applicant amend the passage to read --an influence of an electrostatic field--.

10. Claim 1 recites the limitation "that reversing roller" in line 8. There is insufficient antecedent basis for this limitation in the claim. It is suggested that applicant amend the passage to read --that said reversing roller-- or --that the reversing roller-- to make clear that the claim refers to the previously recited reversing roller.

11. Claim 1 recites the limitation "of material web (4)" in line 6. There is insufficient antecedent basis for this limitation in the claim. It is suggested that applicant amend the passage to read --of said material web (4)-- or --of the material web (4)-- to make clear that the claim refers to the previously recited material web.

12. Claim 1 recites the limitation "of material web (4)" in line 11. There is insufficient antecedent basis for this limitation in the claim. It is suggested that applicant amend the passage to read --of said material web (4)-- or --of the material web (4)-- to make clear that the claim refers to the previously recited material web.

13. Claim 2 recites the limitation "that reversing roller" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is suggested that applicant amend the passage to read --that said reversing roller-- or --that the reversing roller-- to make clear that the claim refers to the previously recited reversing roller.

14. Claim 3 recites the limitation "that reversing roller" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is suggested that applicant amend the passage to read --that said reversing roller-- or --that the reversing roller-- to make clear that the claim refers to the previously recited reversing roller.

15. Claim 4 recites the limitation "that reversing roller" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is suggested that applicant amend the passage to read --that said reversing roller-- or --that the reversing roller-- to make clear that the claim refers to the previously recited reversing roller.

16. Regarding claim 1, the phrase "preferably" (for re-moistening of a paper or textile web dried after printing) in lines 2-3 renders the claim indefinite because it is unclear

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whether the limitations following the phrase "preferably" are part of the claimed invention.

Claim Rejections - 35 USC § 102

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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19. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

20. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakajima et al (USPN 5,138,971) in view of Watanabe (USPN 3,625,743).

Nakajima discloses an apparatus capable of moistening a web that comprises a reversing roller (item 5, figure 4), an electrostatic charging device designed as a corona charging electrode associated with the roller (item 1, figure 4), and a liquid dispensing device (item 9, figure 4, see especially column 3, line 41 to column 5, line 22, and claim 1).

Nakajima only discloses dispensing on one face or side of the web. Nakajima does not disclose structure for dispensing on both faces of the web.

Watanabe discloses dispensers (items 40a and 40b), which dispense to both faces of the web. One in the art would immediately appreciate that spraying on both sides is useful when both sides of the web is being used (such as in magazine paper, wherein both sides carry content), and that spraying on both sides would logically ensure that both sides have similar properties, which is known to be useful for further paper processing, as cited in Watanabe (see column 1, lines 3-22, which discloses the benefits of making paper with homogenous water properties on both sides). Therefore,

it would have been obvious to one of ordinary skill in the art at the time of the invention desiring to ensure homogenous paper properties to use coating devices on both sides of the web as in Watanabe in the overall apparatus of Nakajima.

21. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakajima and Watanabe as applied to claim 1 above, and further in view of Blythe et al (USPN 3,863,108).

Nakajima is silent as to the properties of the reversing roller, except to disclose that it is connected to a ground source (see Figure 4, item 5, which is connected to the universal symbol for ground) as cited in claim 4.

As to claims 2 and 3, Blythe discloses that the reversing roller is preferably highly polished and is even more preferably polished chrome steel, i.e., similar to chrome plated (column 4, lines 18-32). Blythe also discloses chrome plated as another embodiment ("chromium plated roller 2", in column 6, lines 26-33 and "chromium plated roller 23" in column 6, lines 60-68). Chrome materials are known to be good electrical conductors. Blythe also discloses that one would use such a roller "to prevent the film being damaged when it contacts the roller". Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized a polished chrome plated reversing roller which is inherently a good electrical conductor, and smooth due to polishing, as in Blythe in the overall apparatus of Nakajima and Watanabe, in order to prevent damage to the web or film.

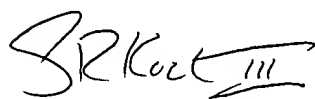
Conclusion


22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPN 3,930,614 discloses another elctrostatic based spraying means, and USPN 6,177,141 B1 discloses another electrostatic based coating means using corona discharge electrodes.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R. Koch III whose telephone number is (703) 305-3435 (TDD only). If the applicant cannot make a direct TDD-to-TDD call, the applicant can communicate by calling the Federal Relay Service at 1-800-877-8339 and giving the operator the above TDD number. The examiner can normally be reached on M-Th 10-7.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (703) 308-3853. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7718 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


George R. Koch III
October 3, 2002


RICHARD CRISPINO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700